

REMARKS

The specification has been corrected to correct typographical errors in “Polyvinyledeen,” “anode” and “cathode.” In particular, the Applicants have checked each occurrence of “anode” and “cathode” and reversed them where they were incorrectly used as “cathode” and “anode,” respectively. Please also note that the other occurrences of “anode” and “cathode” described in the original specification and not amended by this Amendment should be maintained unchanged.

The Examiner rejected claims 1 and 7-11 under 35 USC 112, first paragraph. This rejection is respectfully traversed.¹

Claims 7-9 and 11 depend from claims 1 or 10 and were thus also included in this rejection. This rejection is respectfully traversed and should be withdrawn because claims 1 and 10 have been amended and the carbon electrode is “a solid sheet,” which the Examiner objected as being new matter, is no longer recited in the pending claims. The Examiner states that the subject matter supported by the disclosure “is actually *a sheet of a composite material which includes a carbon component.*” See page 2, lines 8 and 9 of the Action; emphasis added. Accordingly, claims 1 and 10 now recites “a sheet of a composite material comprising a carbon component.”

Claims 1 and 10 were rejected as being anticipated by Kato or Adam. This rejection is respectfully traversed.

The Examiner has agreed that neither Kato nor Adams recite an “electrode.” “An electrode of a secondary battery” as recited in claims 1 and 10 *is* the invention of these claims, *not* the “intended use” as incorrectly presumed by the Examiner. The failure to consider the term “electrode” in claims 1 and 10 as a limitation is totally incorrect because by doing so the Examiner has ignored the invention itself.

¹ Applicants respectfully submit that they do not agree with the Examiner’s position that “the carbon electrode is a solid sheet” is new matter and reserve the right to raise this issue if needed at any subsequent time, though to expedite prosecution the Applicants have amended claims 1 and 10 in accordance with the Examiner’s position as to what is enabled.

Some things *must* be defined with a qualifier “of a ... ” in order to accurately and correctly define the thing. Such a qualifier is *not* intended use but a way to accurately define the thing as understood by persons skilled in the art. For example, a button of coat is totally different from a button of a keyboard. One needs to, and must, define a button of a coat as a button *of a coat* in order to accurately and precisely define this button and to distinguish it over other buttons such as a button of a keyboard. Similarly, the instant claims accurately define the claimed electrodes as *an electrode of a secondary battery* to distinguish over other things that are *not* electrodes of a secondary battery.

“An electrode of a secondary battery” is recited in the preamble of claims 1 and 10. MPEP 2111.02 states, “Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation” citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). The preamble of claims 1 and 10 specifically limit the claims to an “electrode,” not just any device. Thus, the Examiner is required to consider the phrase “[a]n electrode of a secondary battery” in the preamble as a limitation, which is what the inventors actually invented and intended to encompass by the claim. MPEP 2111.02 further states:

(The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention).

The Applicants further respectfully submit on the record that the anticipation rejection of claims 1 and 10 over each of Kato and Adam must fall because *neither Kato nor Adam is an enabling reference* as neither one relates to the invention of claims 1 and 10. Claims 1 and 10 relate to an electrode of a secondary battery comprising a carbon electrode. Persons of ordinary skill in the art of secondary battery would recognize that a carbon electrode of an electrode of a

secondary battery is an anode active material having a large amount of carbon in the carbon electrode.

Kato relates to a wet type sliding apparatus comprising a thrust bearing which operates in the presence of a lubricating liquid and is formed from a resin composition comprising a 10 to 45 weight % of carbon fiber, a fluorocarbon polymer and a thermoplastic resin other than fluorocarbon polymer. Persons of ordinary skill in the art of secondary battery would recognize that the resin composition of Kato is *not* an anode active material.

Adam relates to a self-lubricating bearing comprising a PTFE-containing polymer matrix with fillers comprising PbO in an amount of 15-55 vol. % and at least one metal fluoride in an amount of 0.1-14 vol. %. As can be seen from column 3, lines 45-52, although the Adam mentions fibrous materials which may be graphite fibers, they are merely 'further additives' for the filler combination. Persons of ordinary skill in the art of secondary battery would recognize that the self-lubricating bearing composition of Adam is *not* an anode active material.

In short, neither Kato nor Adam disclose or suggest how a person skilled in this art could make or use the claimed invention, i.e., an electrode of a secondary battery comprising a porous film on a carbon electrode of a secondary battery. Thus, Kato and Adam are *non-enabling* references.

A non-enabling reference does *not* qualify as prior art for making an anticipation rejection. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968).

In addition, the Examiner's argument that "a carbon sheet, to the extent that one is presently disclosed [in Kato], is placed next to a porous metal film" on page 2, lines 5 and 6 from the bottom, of the Action is incorrect. Kato discloses that the thrust bearing can be made excellent in wear resistance by impregnating or coating a porous sintered layer backed with a metal, *not* a porous metal layer, with the resin composition.

Claims 2-4 and 6 were allowed.

The Examiner indicated that claims 7-9 and 11 would be allowed if rewritten to overcome the rejection under 35 USC 112, first paragraph, and to include all of the limitations of the base claim and any intervening claims. Applicants have amended claims 7-9 and 11 as suggested by the Examiner.

In light of this Amendment, a Notice of Allowance is respectfully solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952**, referencing docket number **300602002100**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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